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| 10/524,637 | 02/16/2005 | Boris Mayer | 30882/DP023 | 1456 |
| 4743 7590 01/02/2009 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606 | | | EXAMINER VERDI, KIMBLEANN C | |
| | | | ART UNIT 2194 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,637

Applicant(s)

MAYER ET AL.

Examiner

KimbleAnn Verdi

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2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 10-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date December 9, 2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claims 10-12 are pending in the current application.

Claim Objections

1. Claim 10 is objected to because of the following informalities: line 5, the recitation of "request" should be "requests". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claim 12 recites a "A device for transmission of notifications to users of an electronic parcel compartment system" however, it appears that a device for transmission of notifications to users of an electronic parcel compartment system would reasonably be interpreted by one of ordinary skill in the art as software, per se since the body of the claim appears to be software. Applicant claims a database, a central sending component, communication interface, an external interface, and a storage module, as described by Applicant's specification, appear to be data structures which are functional descriptive material. However, function descriptive material is

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nonstatutory when claimed as descriptive material per se. Applicant describes the functionality of a database, a central sending component, communication interface, an external interface, and a storage module but does not disclose any hardware structure of the claimed device. As such, it is believed that a device for transmission of notifications to users of an electronic parcel compartment system of claim 12 is reasonably interpreted as functional descriptive material, per se and non statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tilles et al. (hereinafter Tilles) (U.S. Patent 6,748,295 B2) in view of Weiser (WO 02/29731 A1), and further in view of Reed et al. (hereinafter Reed) (U.S. Publication No. 2002/0095454 A1).**

7. As to claim 10, Tilles teaches the invention substantially as claimed including a method for the transmission of notifications by a notification component to users of an electronic parcel compartment system within a postal shipping system, comprising:

transmitting data from at least one database to a central sending component (e.g. from master server to web server, col. 13, lines 34-37) upon requests for the transmission of notifications (e.g. customer registers for the service, col. 13, lines 38-40),

transmitting the notification information to a communication interface (e.g. from web server to modem, col. 4, lines 2-5) and from the communication interface to at least one receiving device (e.g. a customer delivery terminal, col. 4, lines 16-24),

storing notification jobs in a storage module (e.g. registering and storing address in master server, col. 13, lines 38-40) and transmitting at least some of the requests for the transmission of notifications by a control circuit to the storage module (e.g. activating the service, col. 13, lines 43-55), and

acquiring the notification jobs contained in the storage module by a reading module (e.g. front office client when item placed in carousel, col. 3, lines 66-67 and col. 4, lines 1-5 and 16-24) and transmitting the notification jobs to the central sending component (e.g. sending to web server, col. 13, lines 34-37),

transmitting (e.g. emailing) the information for creating notification jobs to the control circuit (e.g. IDRS system) via an external interface (e.g. customer registers via internet col. 13, lines 38-40 and 50-55),

whereby the information for creating notification jobs depends on events within the electronic parcel compartment system (col. 13, lines 34-37 and 50-51), and

the events triggering defined, definable or variable processing steps by the notification component (e.g. email notification generated when item stored in carousel , col. 13, lines 35-37 and 50-55).

8. Tilles does not explicitly disclose converting the data in the central sending component into notification information;

categorizing the events in classes; and

transmitting the notifications to at least one user for whom the event is defined to be pertinent.

9. In addition Weiser teaches converting the data in the central sending component into notification information (e.g. from data capture devices to email address, page 6, lines 1-10); and

transmitting the notifications as SMS to at least one user for whom the event is defined to be pertinent (steps 5-7, Figure 1, page 6, lines 1-31).

10. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified IDRS system of Tilles with the teachings of notification server from Weiser because this feature would have provided a mechanism for a mailbox owner with an electronic, easily accessible, secure, and rapid notification when mail/parcels have been distributed into their real and/or virtual mailboxes (page 3, lines 7-10 of Weiser).

11. Tilles as modified by Weiser does not explicitly disclose categorizing the events in classes.

12. However Reed teaches categorizing the events in classes (Event 116 class, Fig. 3, is an abstract class defining the attributes for Scheduled Events 117, Fig. 3 and logged events 118, Fig. 3, paragraph [0140]).

13. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have further modified the IDRS system events of Tilles as modified by Weiser with the teachings of Events from Reed because this feature would have further provided a mechanism to track System events for purposes of accumulated statistics, tracking user or communications object activity, documenting errors, providing payment transaction receipts (paragraph [0140] of Reed), and coordination of package deliveries over a physical communications network such as a postal network (paragraph [0531] of Reed).

14. As to claim 11, Tilles as modified by Weiser teaches using at least one template (e.g. appropriate address selected based on service type, page 4, lines 1-10), the central sending component converting the data transmitted from the database into the notification information (page 4, lines 1-10).

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15. As to claim 12, this claim is rejected for the same reason as claim 10, see the rejection to claim 10 above.

Response to Arguments

16. Applicant's arguments with respect to claims 10 -12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KimbleAnn Verdi whose telephone number is (571)270-1654. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST..

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 26, 2008

KV

/Li B. Zhen/

Primary Examiner, Art Unit 2194